

DETAILED ACTION

Election/Restrictions

Applicant's election of species with a carrier base that is a solid cosmetic stick in the reply filed on November 16, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 6, 8-12, and 14-15 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 112

Claims 3, 7, and 13 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant regards as their invention. Evidence that claims 3, 7, and 13 fail to correspond in scope with that which applicant regards as the invention can be found in the specification. Applicant has stated that there are several preferred embodiments that include cosmetically acceptable compositions and particular delivery systems that contain the claimed zinc zeolite in conjunction with other ingredients (see paragraphs 29-35). The statements presented in the description of the invention indicate that the invention is different from what is defined in the claims because claim 1 exclusively directed to a zinc zeolite (see claims 1-2 and 4-5).

According to MPEP 2111.03, "the transitional phrases 'comprising', 'consisting essentially of' and 'consisting of' define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim. The

transitional term ‘comprising’, which is synonymous with ‘including,’ ‘containing,’ or ‘characterized by,’ is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *> Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) (“like the term ‘comprising,’ the terms ‘containing’ and ‘mixture’ are open-ended.”).*< Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) (“The transition comprising’ in a method claim indicates that the claim is open-ended and allows for additional steps.”); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (“Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (“comprising” leaves “the claim open for the inclusion of unspecified ingredients even in major amounts”)...The transitional phrase ‘consisting of’ excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (“consisting of” defined as “closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.”)... The transitional phrase ‘consisting essentially of’ limits the scope of a claim to the specified materials or steps ‘and those that do not materially affect the basic and novel characteristic(s)’ of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original)... ‘A “consisting essentially of” claim occupies a middle ground between closed claims that are written in a “consisting of” format and fully open claims that are drafted in a “comprising” format.’ *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998)... For the purposes of searching for and applying prior

art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, ‘consisting essentially of’ will be construed as equivalent to ‘comprising.’ See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 (“PPG could have defined the scope of the phrase consisting essentially of’ for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.”).

In short, the applicant has framed a series of claims that depend from a claim written in closed (consisting of) claim language (see claim 1). In as much as using the “consisting of” claim construction limits the bounds of claim 1 to only a zinc zeolite, this construction also prohibits subsequent dependent claims from adding further components to the agent claimed in claim 1. Based upon the recitations of the specification and the construction of the subsequent claims, it appears that the applicant intended to claim a composition where the zinc zeolite is the deodorizing agent and is present along with other components. However, the claims as constructed do not claim such a composition.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim of issue is improperly constructed as a Markush claim with open claim language. MPEP 2111.03 discusses the proper closed claim language construction for Markush claims. “In Gillette Co. v. Energizer Holdings Inc., 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005), the court held that a claim to ‘a safety razor blade unit comprising a guard, a cap, and a group of first, second, and third blades’ encompasses razors with more than three blades because the transitional phrase ‘comprising’ in the preamble and the phrase ‘group

of' are presumptively open-ended. 'The word "comprising" transitioning from the preamble to the body signals that the entire claim is presumptively open-ended.' Id. In contrast, the court noted the phrase 'group consisting of' is a closed term, which is often used in claim drafting to signal a "Markush group" that is by its nature closed. Id."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Berry (US Patent No. 3,654,185).

Berry teaches a zinc zeolite that is made from zinc acetate and SK-40 sodium zeolite (see example 2; instant claims 1-2 and 4-5). Although instant claim 1 has a preamble reciting a "deodorizing agent", a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In addition, instant claim 1 also recites an intended use ("for topical application") that is not given patentable weight. All zinc zeolite is either in hydrated or anhydrous form, therefore the zinc zeolite taught by Berry anticipates instant claim 2. The creation of zinc zeolite in essence creates an agent that is entirely zinc zeolite (contains 100% zinc zeolite; see instant claim 4).

Instant claim 5 recites a product-by-process. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (See MPEP 2113). Thus instant claim 5 is also anticipated by Berry who teaches the claimed structure, zinc zeolite. Therefore, claims 1-2 and 4-5 are anticipated by and unpatentable over Berry.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending application number 10/710011. Although the conflicting claims are not identical, they are not patentably distinct from each other

because both the instant claims and those of the copending application claim a zinc zeolite that is hydrated or anhydrous and both also have the improper addition of a carrier base to the agent that consists of zinc zeolite. Therefore, claims 1-4 are obvious over copending application 10/710011.

Claims 1-4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 5 of copending Application number 11/760466. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claims and those of the copending application claim a zinc zeolite that is hydrated or anhydrous and both also have a claim to the addition of a carrier base to the agent. Although application 11/760466 uses open language to define the components of the composition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the single component recited in the claim as the sole component of the composition. Therefore, claims 1-4 are obvious over copending application 11/760466.

These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caralynne Helm whose telephone number is 571-270-3506. The examiner can normally be reached on Monday through Thursday 8-4 (EDT).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel or Cecilia Tsang can be reached on 571-272-0718 or 571-272-0563, respectively. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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